

DETAILED ACTION

Response to Amendment

1. The amendments, filed 11/30/2011, have been entered and made of record. Claims 1, 3, 7-11, 17-19 are pending.

Response to Arguments

2. Applicant's arguments filed 11/30/2011 have been fully considered but they are not persuasive. See the reasons sets forth below.

Applicants state, "Funahashi in [paragraph 0110] discloses modality apparatus and image viewer that send diagnostic image files with added record indication information. The recording indication information is used to specify a medium used for recording. Based on the record indication information, an image file server either temporarily stores the diagnostic image files on the hard disk or permanently archives the diagnostic image files on a removable medium."

Hence Applicants noted and agreed that the applied prior art of Funashashi discloses indication information and the applied prior art apparatus used this indication information either to save the image temporarily on the hard disk or permanently on the removable medium.

Applicants state, "in Funahashi (i.e., steps S54-S57 of fig. 11), whether a recording medium is specified is not a consideration at the time of permanent or temporary storage of content. That is, a recording medium used for permanent storage is clearly not specified at the time of permanent storage. Instead, if a removable medium is mounted on the media drive, data is automatically recorded onto the removable medium regardless of whether it is specified removable medium that is desired by the user."

The Examiner respectfully disagrees. First, the present application claims are silent in regard to specifying recording medium desired by the user. Therefore this argument is moot. Second, data is not automatically recorded to the recording medium when the recording medium is mounted on the media drive. The applied prior art clearly states, if free capacity does not exist in the removable medium currently loaded, the image is stored in the hard disk (see paragraph 0138 for instance). The medium that is loaded on the drive is always checked if there is enough capacity on it or not. More than one medium also can be loaded and identified if there is enough capacity on the loaded medium. Therefore the prior art teaches specifying whether enough capacity exists in the currently loaded medium or not. It does not automatically record the image as Applicants stated.

Applicant states, in regard to the applied prior art of Taoda, "... the medium numbers disclosed by Taoda are merely management information for specifying recording areas of optical disks in an internal disk array; and the table in Fig. 4 merely shows information regarding management for changing disks in an audio-changer in an optical disk library apparatus."

In response the Examiner respectfully disagrees. The above conclusion by Applicants found no support in the applied prior art. Col. 13 line 62-col. 14 line 3 of the applied prior art discloses the CPU determining whether the optical disk 30 belonging to medium group '1', and having medium number '1.' All the disclosure associated with figure 4 do not disclose the said medium numbers of the prior art being "merely management information for specifying recording areas of optical disks in an internal disk array."

Instead Taoda discloses identifying the loaded disk based on medium number and group number (see for instance col. 10 line 64-col. 11 line 6) by referring to optical disk management table. Taoda further teaches temporarily storing data on memory 13 and transferring the data to specific optical disk which has specific medium number and group number (see col. 9 lines 20-29 and col. 12 lines 30-39). See also col. 13 lines 54-61 where the prior art discloses the CPU determines which optical disk should be accessed on the basis of the

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medium group number and the medium number, and the CPU also checks which optical disk are loaded on the basis of drive-management table. The drive management table includes medium group number and medium number (see col. 4 lines 47-52).

Therefore the group number and medium number of the prior art of Taoda uniquely identifies the optical disk 30 loaded on the drive unit.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention as made to substitute specifying disk capacity of loaded medium with specifying group number and medium number of the disk in order to designate the optical disk used for storing the file data.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case,

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Applicants states, "one of ordinary skill in the art would not be motivated to apply the management information of Taoda, which is simply used to manage the changing of disks in the device, to the portable recording medium of Funahashi, in an attempt to arrive the present invention...." This argument is not persuasive as Taoda discloses more than changing of disks as stated above. See also the motivation above.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of the references teaches the limitation as claimed.

In view of the above, the claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funahashi (US PG PUB 2002/0081039) in view of Taoda (US Pat. No. 5, 875, 459).

Regarding claim 1, Funahashi discloses a recording apparatus for recording contents, said recording apparatus comprising:

- a drive unit operable to have a portable recording medium removably attached (see figure 4, media drive 25 and removable media);

- a relief recording medium (see figure 4 HDD 24 (temporal storage));

- an obtaining unit operable to obtain specification information which specifies a portable recording medium to be used for recording a content (see paragraph 0110 record indication information specifies a medium and based on the information image files to be stored in the medium);

- a recording control unit operable to perform control so that (i) in a case where a portable recording medium currently attached to said drive unit is identified as having enough capacity when the content is

to be recorded, the content is recorded onto the attached portable recording medium, and (ii) in a case where the portable recording medium currently attached to the said drive unit is identified as not having enough capacity when the content is to be recorded, the content is recorded onto said relief recording medium (see figure 11 which shows in step 54 determining whether removable medium loaded or not, and if loaded the process goes to step 57 to record the image files on the detected removable medium, otherwise the process goes to step 55 where the image files stored on the HD (step 55); see the above response) ; and

a dubbing control unit operable to, when triggered by a detection that the specified recording medium media is attached to said drive unit after the content has been recorded onto the relief recording medium, dub the recorded content from said relief recording medium onto the specified portable recording medium (see figure 11 step 56 where the system checks if new medium loaded or not, and if so the process goes to step 57 where the image files recorded from the hard disk to the removable storage medium). See also paragraphs 0134-0138.

Claim 1 differs from Funahashi in that the claim further requires identifying the medium in drive unit using uniquely identifier.

In the same field of endeavor Taoda discloses identifying the medium in drive unit using uniquely identifier (see figure 4 which shows optical disk drive management table includes medium number; see col. 13 line 62-col. 14 line 3, CPU 12 determines which group the optical disk belonging to and the number of the medium.) See also the response above.

Therefore in light of the teaching in Taoda it would have been obvious to one of ordinary skill in the art at the time the invention as made to substitute specifying disk capacity of loaded medium with specifying group number and medium number of the disk in order to designate the optical disk used for storing the file data, and in order to record file in a single or plurality of optical disk, permit accessing a file in higher speed, and identify specific disk.

Note to the Applicant: The USPTO considers the Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements.

Regarding claims 17-19, the limitation of claims 17-19 can be found in claim 1 above. Therefore claims 17-19 are analyzed and rejected for the same reason as discussed in claim 1 above.

Regarding claim 3, Taoda discloses each portable recording medium has the piece of identification information recorded thereon; and said recording control unit judges whether the specified portable

recording medium is attached to the said drive unit, by comparing a piece of identification information recorded on the currently attached portable recording medium with the piece of identification information used by the specification information (see col. 9 lines 20-32 and col. 13 lines 54-61, col. 14 lines 18-21).

5. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funahashi (US PG PUB 2002/0081039) Taoda (US Pat. No. 5, 875, 459) and further in view of Noguchi (US PG PUB 20050008346).

Regarding claim 7, although the combination of Funahashi and Taoda discloses the limitation of claim 1, the combination fails to specifically disclose obtaining unit is further operable to obtain time information which indicates a time at which the content is broadcasted as a broadcast program, and the recording control unit performs the control so that the content is recorded at the time indicated by the time information.

In the same field of endeavor Noguchi discloses obtaining unit is further operable to obtain time information which indicates a time at which the content is broadcasted as a broadcast program, and the recording control unit performs the control so that the content is recorded at the time indicated by the time information (see figure 1, timer section 36, paragraph 0064 timer section counts clock signals to

generate date and hour information, see paragraph 0081 CPU controls the recording based on the time information).

Therefore in light of the teaching in Noguchi it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination by providing timer information and controls the recording function based on the preselected time information in order to reserve/store user desired content when the user is away from the recording/playback device.

Regarding claim 8, Noguchi discloses the obtaining unit obtains the specification information and the time information based on a piece of preprogramming information provided by a user who preprograms the recording of the content. (see paragraph 0080, optical disk having disk number 4; see paragraph 0067, user specifies which disk to use; see paragraph 0127 user enters recording date).

Regarding claim 9, Noguchi discloses a piece of preset information is recorded on the specified portable recording medium, the piece of preset information instructing that the content should be recorded and including the time information; and when the piece of preset information is read from the portable recording medium (see paragraph 0079 user specifies optical disc subjected to the recording, see paragraph 0080-0081 content recorded on specified medium, see paragraph 0069 program information recorded in each disc includes

recording date and hour), the obtaining unit obtains (i) the specification information for instructing that the content should be recorded onto the portable recording medium having the piece of preset information (see paragraph 0080 optical disc having disc number 4 specified and the content recorded on the specified disc), and (ii) the time information included in the piece of preset information (see paragraph 0069 recording date and hour recorded on the optical disc).

Regarding claim 10, Funahashi discloses an area releasing unit operable to, in a case where after the time indicated by the time information has arrived and the content is not recorded on either of said relief recording medium and the specified portable recording medium having the piece of preset information recorded thereon, release an area that is within the specified portable recording medium having the piece of preset information and is reserved for the recording of the content (see figure 9 steps 34-36 and paragraph 0128 if enough capacity does not exist in the removable medium currently loaded, a reservation is made on the medium).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Funahashi (US PG PUB 2002/0081039) Taoda (US Pat. No. 5, 875, 459) and further in view of Noguchi (US PG PUB 20050008346) and further in view of Official Notice.

Regarding claim 11, although the combination of Funahashi, Taoda and Noguchi discloses the limitations of claim 1 and 9, the combination fails to specifically disclose an area releasing unit operable to, in a case where the piece of preset information is deleted from the specified portable recording medium, release an area that is within the specified portable recording medium having the piece of preset information and is reserved for the recording of the content.

Official Notice is taken that it is well known in the recording and reproducing art having free area in a recording medium after deletion of recorded information. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination by editing the information recorded on the disk in order to record the more updated or desired content by erasing the old content.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

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this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-TR, 8:30AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/HELEN SHIBRU/
Primary Examiner, Art Unit 2484
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